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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,704	01/26/2004	William D. Ramsden	87069SLP	9205

70523 7590 12/31/2009

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EXAMINER	
WALKE, AMANDA C	
ART UNIT	PAPER NUMBER
1795	
MAIL DATE	DELIVERY MODE
12/31/2009	PAPER

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM D. RAMSDEN, DOREEN C. LYNCH,
PAUL G. SKOUG, and JAMES B. PHILIP, JR.

Appeal 2009-002984
Application 10/764,704
Technology Center 1700

Decided: December 30, 2009

Before: LINDA M. GAUDETTE, KAREN M. HASTINGS, and MICHAEL P. COLAIANNI, *Administrative Patent Judges.*

COLAIANNI, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1 through 11 and 13 through 31. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

The subject matter on appeal is directed to an aqueous-based, thermally-developable black-and-white composition. The Examiner rejects claims 1-11 and 13-31[1] under 35 U.S.C. § 103(a) over Simpson '649 (6,440,649 B1, published Aug. 27, 2002) or Simpson '033 (6,573,033 B1, published Jun. 3, 2003) in view of Masuta[2] (FR 1542505 B, published Oct. 18, 1968) or Taguchi[3] (JP 02-048659, published Aug. 11, 1988)[4].

ISSUE

Did the Examiner reversibly err by failing to consider anew the prima facie case of obviousness by evaluating all the evidence of non-obviousness, including unexpected results, against the facts on which the Examiner's prima facie case of obviousness is based? We decide this issue in the affirmative.

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[1] As is apparent from the amendment entered on August 25, 2005, claim 12 has been canceled.

[2] Since both Appellants and the Examiner refer to this reference as "Masuta," we do the same. Moreover, our reference to Masuta is to the translation thereof prepared for the U.S. Patent and Trademark Office by The McElroy Translation Company (PTO 09-5754, June 2009).

[3] Our reference to Taguchi is to the translation thereof prepared for the U.S. Patent and Trademark Office by Schreiber Translation, Inc. (PTO 09-5767, June 2009).

[4] We note that Appellants' statement of the rejection made at page 11 of the Appeal Brief is harmless error since it is apparent from page 3 of the Answer that the claims are rejected over Simpson '649 or Simpson '033 in view of Masuta *or* Taguchi.

FINDING OF FACT

1. The Examiner has provided no statement that Appellants' evidence of unexpected results disclosed in the Specification has been considered, much less identified reasons as to why the Examiner believes that the evidence of obviousness when considered anew in light of all of the Appellants' evidence of nonobviousness weighs in favor of obviousness. (*See* Answer in its entirety).

PRINCIPLES OF LAW

As stated in *In re Rinehart*,

> When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over. Though the burden of going forward to rebut the prima facie case remains with the applicant, the question of whether that burden has been successfully carried requires that the entire path to decision be retraced. An earlier decision should not, as it was here, be considered as set in concrete, and applicant's rebuttal evidence then be evaluated only on its knockdown ability. Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened umbrella effect. Prima facie obviousness is a legal conclusion, not a fact. Facts established [sic] by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself.

531 F.2d 1048, 1052 (CCPA 1976). The totality of the evidence (e.g., evidence of unexpected results and evidence of obviousness) must be weighed to determine whether the claimed invention by a preponderance of the evidence would have been obvious. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS AND CONCLUSION

Appellants argue that

> Appellants have demonstrated that the compounds within the scope of the present invention unexpectedly provide improved results over the use of ascorbic acid (see Appellants' Examples 1 and 2, pages 46-57 with data in TABLES III and IV). The data demonstrate an advantage especially for the improvement in post-processing print stability ("Light Box Test" in TABLE III and the reduced change in Dmin shown in TABLE IV).

(Br. 13).

In other words, Appellants refer to evidence of unexpected results in their Specification to support their position that the preponderance of the evidence weighs in favor of nonobviousness. The Examiner must evaluate this evidence of unexpected results against the facts on which the Examiner's prima facie case of obviousness is based to determine whether the claimed invention would have been obvious.

On this record, however, the Examiner has not done so. In this regard, the Examiner has provided no statement that this evidence has been considered, much less identified reasons as to why the Examiner believes that the evidence of obviousness when considered anew in light of all of the Appellants' evidence of nonobviousness weighs in favor of obviousness. (FF 1).

Because the Examiner has failed to weigh the totality of the evidence, it follows that the Examiner reversibly erred by failing to consider anew the prima facie case of obviousness by evaluating all the evidence of nonobviousness, including unexpected results, against the facts on which the Examiner's prima facie case of obviousness is based in concluding that the claimed invention would have been obvious.

Accordingly, we reverse the Examiner's decision rejecting claims 1-11 and 13-31 under 35 U.S.C. § 103.

DECISION

For the above reason, the Examiner's rejection is reversed.

REVERSED

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